

Appl. No. 10,720,625  
Docket No. GP-302436 (GM2-0082)

### **REMARKS / ARGUMENTS**

#### **Status of Claims**

Claims 1-18 are pending in the application. During a June 22, 2004, telephone conversation between the Examiner and Applicant's Attorney, the invention of Species A, Claims 1-10, were provisionally elected with traverse. Claims 11-18 have been withdrawn from consideration pending affirmation of the elected species by Applicant. Claims 1-10 are rejected.

Applicant has amended Claim 10, and traverses the restriction, leaving Claims 1-18 for consideration upon entry of the present Amendment.

Applicant respectfully submits that the restriction has been traversed, and that the rejections under 35 U.S.C. §102(b) and 35 U.S.C. §103(a) have been traversed, that no new matter has been entered, and that the application is in condition for allowance.

#### **Status of Drawings**

The drawings filed on 24 November 2003 are accepted by the Examiner.

#### **Objections to the Specification**

The Examiner objected to the specification for reasons relating to informalities appearing in Claim 10.

Applicant has amended Claim 10 to correct for the informalities.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the objection.

#### **Election/Restriction Requirement**

Applicant has elected the invention of Species A, Figures 1-4, with traverse, and submits that Claims 1-10 read on the invention of Species A.

Additionally, however, Applicant respectfully traverses the Election / Restriction requirement for the following reasons.

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The Examiner alleges that Species A, Figures 1-10, and Species B, Figures 5 and 6, are each directed to a patentably distinct species, and that none of the claims are generic.

In respectful disagreement with the Examiner, Applicant submits that Claim 1 is generic to both Species A, Figures 1-4, and Species B, Figures 5 and 6.

Specifically regarding independent Claim 1 with respect to Species A, Figures 1-4, Applicant submits that Claim 1 is directed to an extendable bumper system for a vehicle, the extendable bumper system comprising:

- a bumper structure (14);
- a laterally extending bumper segment (22) slideably located within the bumper structure (14); and
- an actuator (28) in operable communication between the bumper structure (14) and the laterally extending bumper segment (22).

Specifically regarding independent Claim 1 with respect to Species B, Figures 5 and 6, Applicant submits that Claim 1 is also directed to a an extendable bumper system for a vehicle, the extendable bumper system comprising:

- a bumper structure (14);
- a laterally extending bumper segment (22) slideably located within the bumper structure (14); and
- an actuator (28) in operable communication between the bumper structure (14) and the laterally extending bumper segment (22).

In view of Claim 1 being both independent and generic and reading on both Species A, Figures 1-4, and Species B, Figures 5 and 6, Applicant respectfully submits that a restriction of the species identified as Species A and B for examination purposes is improper.

For at least this reason, this Restriction Requirement is wholeheartedly traversed, and removal of the Requirement, at least with respect to the improper groupings noted above, is respectfully requested.

Consideration and allowance of these claims are respectfully requested.

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### **Rejections Under 35 U.S.C. §102(b)**

Claims 1, 3, 7, 8 and 10, stand rejected under 35 U.S.C. §102(b) as being anticipated by Muselli et al. (U.S. Patent No. 5,213,383, hereinafter Muselli). The Examiner comments that Muselli discloses all elements of the noted claims.

Applicant traverses this rejection for the following reasons.

Applicant respectfully submits that “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, *in a single prior art reference.*” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). Moreover, “[t]he identical invention must be shown in as complete detail as is contained in the \*\*\* claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Furthermore, the single source must disclose all of the claimed elements “arranged as in the claim.” *Structural Rubber Prods. Co. v. Park Rubber Co.*, 749 F.2d 707, 716, 223 U.S.P.Q. 1264, 1271 (Fed. Cir. 1984). Missing elements may not be supplied by the knowledge of one skilled in the art or the disclosure of another reference. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 780, 227 U.S.P.Q. 773, 777 (Fed. Cir. 1985).

Regarding independent Claim 1, the Examiner acknowledges that Muselli does not disclose that the side telescoping members (6, 7) are operable by an actuator, but alleges that “...it would have been *inherent* to operate the side telescoping members in the same manner as the forward telescoping members (4)...”. Paper 20040618, page 4 (emphasis added).

In respectful disagreement with the Examiner, Applicant finds no support in Muselli for the alleged inherency, and the Examiner has not stated with specificity where the necessary element supporting inherency may be found.

At Col. 2, lines 15-16, Applicant finds Muselli to disclose “a pair of laterally telescopic arms 6.”

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At Col. 2, lines 56-57, Applicant finds Muselli to disclose "the bumper width is also adjusted in relation to the size of both the load and the vehicle."

Contrary to the Examiner's allegation, Applicant does not find Muselli to specifically disclose "an actuator in operable communication between the bumper structure and the laterally extending bumper segment," as claimed in the instant invention. While avoiding an admission but allowing that it may be possible to modify Muselli to arrive at the claimed invention, it is still improper to base an anticipation rejection on possibilities or probabilities. Rather, an anticipation rejection must be based on the disclosure of each and every element of the claimed invention, either expressly or inherently, in a single prior art reference, which is not accomplished by applying Muselli to the instant invention.

The Examiner alleges that anticipation of the claimed actuator is inherent in Muselli. Applicant respectfully disagrees. While Muselli discloses a pair of laterally telescopic arms, it is just as likely as not, and without more disclosure, that Muselli achieves an extension/retraction of the laterally telescopic arms by manual means, and not by "an actuator in operable communication between the bumper structure and the laterally extending bumper segment," as claimed in the instant invention. Where Muselli does not disclose the use of an actuator in operable communication between the bumper structure and the laterally extending bumper segment, and does not disclose, either textually or illustratively, a necessary element, such as an actuator, for achieving a lateral extension of the laterally extending bumper segment, Muselli cannot properly be used to show anticipation by inherency.

In Muselli, Applicant submits that it is not necessary to use an actuator for adjusting the pair of laterally telescopic arms. Accordingly, Muselli does not inherently disclose this feature.

By alleging anticipation through inherency absent specific reference to a necessary element that must be present in the cited reference, Applicant respectfully submits that the Examiner has failed to properly meet the burden of a showing of anticipation.

Dependent claims inherit all of the limitations of the parent claim.

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**Regarding Claim 8 Specifically**

The Examiner alleges that Muselli discloses the extendable bumper system of claim 3, wherein the locking mechanism is further configured to lock the laterally extending bumper segment in an extended position *prior to* and during an event. Paper 20040618, page 4 (emphasis added).

In respectful disagreement with the Examiner, Applicant finds Muselli to disclose a telescopic support that "activates a pair of control units... which are able to activate the vehicle control devices *in the event that the bumper collides with* an obstacle along the route." Col. 2, lines 38-43 (emphasis added). Also, Applicant finds Muselli to disclose a telescopic support assembly that retracts or rotates "*in the event of collision* with an obstacle while the vehicle is moving." Col. 2, lines 58-60 (emphasis added). Here, Applicant finds the Muselli bumper to be reactive to a collision, and not to be "configured to lock the laterally extending bumper segment in an extended position *prior to* and during an event," as claimed in the instant invention. While Muselli is reactive to a collision, the instant invention is proactive to an impending collision, which is a substantially different invention.

Accordingly, Applicant finds the instant invention to be patentably distinguishable over Muselli.

In view of the foregoing remarks, Applicant submits that Muselli does not disclose each and every element of the claimed invention and therefore cannot be anticipatory. Accordingly, Applicant respectfully submits that the Examiner's rejection under 35 U.S.C. §102(b) has been traversed, and requests that the Examiner reconsider and withdraw this rejection.

**Rejections Under 35 U.S.C. §103(a)**

Claims 2, 4, 5, 6 and 9 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Muselli in view of Wathen (U.S. Patent No. 3,848,914, hereinafter Wathen).

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The Examiner acknowledges that Muselli does not disclose certain features of the claimed invention, and looks to Wathen to cure these deficiencies.

Applicant traverses the Examiner's rejections for the following reasons.

Applicant respectfully submits that the obviousness rejection based on the References is improper as the References fail to teach or suggest each and every element of the instant invention. For an obviousness rejection to be proper, the Examiner must meet the burden of establishing a prima facie case of obviousness. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). The Examiner must meet the burden of establishing that all elements of the invention are taught or suggested in the prior art. MPEP §2143.03.

Claims 2, 4, 5, 6 and 9, are all dependent from Claim 1, and Applicant has remarked above how Claim 1 is patentable over Muselli. In consideration of the absence of anticipatory elements in Muselli, Applicant respectfully submits that Wathen fails to cure the noted deficiencies of Muselli. Specifically, Applicant submits that Wathen fails to disclose "an actuator in operable communication between the bumper structure and the laterally extending bumper segment," as claimed in the instant invention. Accordingly, Wathen in combination with Muselli fails to meet the standards of a prima facie case of obviousness, and therefore cannot properly be used for rejection on those grounds.

In view of the foregoing, Applicant submits that the References fail to teach or suggest each and every element of the claimed invention and discloses a substantially different invention from the claimed invention, and therefore cannot properly be used to establish a prima facie case of obviousness. Accordingly, Applicant respectfully requests reconsideration and withdrawal of this rejection.

#### **Regarding Claims 11-18**

Applicant has remarked above regarding traversal of the restriction, and also herein remarks that neither Muselli nor Wathen, taken singly or in combination, anticipate or teach the claimed invention. Accordingly, Applicant submits that Claims 11-18 are in condition for allowance, and herein respectfully requests notice thereof.

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In light of the forgoing, Applicant respectfully submits that the Examiner's rejections under 35 U.S.C. §102(b) and 35 U.S.C. §103(a) have been traversed, and respectfully requests that the Examiner reconsider and withdraw these rejections.

The Commissioner is hereby authorized to charge any additional fees that may be required for this amendment, or credit any overpayment, to Deposit Account No. 06-1130.

In the event that an extension of time is required, or may be required in addition to that requested in a petition for extension of time, the Commissioner is requested to grant a petition for that extension of time that is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to the above identified Deposit Account.

Respectfully submitted,

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